

REMARKS

Claim Rejections

Claims 1 and 2 are rejected under 35 U.S.C. § 102(e) as being anticipated by Horng et al. Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Horng et al. and further in view of Miyasaka et al.

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

New Claims

By this Amendment, Applicant has canceled claims 1-4 and has added new claims 5-8 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward an oil-circulating structure for a fan (100) comprising: an oily-bearing (140) located in a fan housing (110) of the fan and having: a central axis hole (141) extending through a center thereof, a fan shaft (131) of a fan hub (130) of the fan being rotatably inserted into the central axis hole; and a hollow oil-collecting recess trench (142) extending into an interior peripheral wall of the central axis hole and being spaced apart from two opposing ends of the central axis hole, the hollow oil-collecting recess trench having: a left-handed internal thread oil-guiding trench (143) formed in an interior peripheral wall of and spirally extending a length of the hollow oil-collecting recess trench; and a right-handed internal thread oil-guiding trench (144) formed in the interior peripheral wall of and spirally extending the length of the hollow oil-collecting recess trench.

Other embodiments of the present invention include: the left-handed internal thread oil-guiding trench and the right-handed internal thread oil-guiding trench are spaced apart from the fan shaft; the left-handed internal thread oil-guiding trench is

a ditch having a V-shaped cross-section; and the right-handed internal thread oil-guiding trench is a ditch having a V-shaped cross-section.

The primary reference to Horng et al. teaches a first guiding groove set (20) and a second guiding groove set (30) are directly formed in the inner surface of the axis hole of the bearing (10). The first guiding groove set (20) includes a plurality of first guiding grooves (21) extending from a first distal end (13) and terminating in the vicinity of a second distal end (14) to define a plurality of first convergent points (22). Similarly, the second guiding groove set (30) includes a plurality of second guiding grooves (31) extending from a second distal end (14) and terminating in the vicinity of the first distal end (13) to define a plurality of second convergent points (32). When lubricant flows to the first convergent points (22), it is impossible to flow back to the second convergent points (32). Oil circulation is poor. There is no evidence showing that the guiding grooves (21 and 31) are thread ditches, and the guiding grooves (21 and 31) are not formed in an oil-collecting recess trench.

Horng et al. do not teach a hollow oil-collecting recess trench extending into an interior peripheral wall of the central axis hole and being spaced apart from two opposing ends of the central axis hole; nor do Horng et al. teach the hollow oil-collecting recess trench having a left-handed internal thread oil-guiding trench formed in an interior peripheral wall of and spirally extending a length of the hollow oil-collecting recess trench, and a right-handed internal thread oil-guiding trench formed in the interior peripheral wall of and spirally extending the length of the hollow oil-collecting recess trench.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Horng et al. do not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Horng et al. cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Miyasaka et al. teaches a porous bearing system and is cited for teaching a bearing (3) having a bore (5) with a v-shaped groove.

Miyasaka et al. do not teach a hollow oil-collecting recess trench extending into an interior peripheral wall of the central axis hole and being spaced apart from two opposing ends of the central axis hole; nor do Miyasaka et al. teach the hollow oil-collecting recess trench having a left-handed internal thread oil-guiding trench formed in an interior peripheral wall of and spirally extending a length of the hollow oil-collecting recess trench, and a right-handed internal thread oil-guiding trench formed in the interior peripheral wall of and spirally extending the length of the hollow oil-collecting recess trench.

Even if the teachings of Horng et al. and Miyasaka et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a hollow oil-collecting recess trench extending into an interior peripheral wall of the central axis hole and being spaced apart from two opposing ends of the central axis hole; nor does the combination suggest the hollow oil-collecting recess trench having a left-handed internal thread oil-guiding trench formed in an interior peripheral wall of and spirally extending a length of the hollow oil-collecting recess trench, and a right-handed internal thread oil-guiding trench formed in the interior peripheral wall of and spirally extending the length of the hollow oil-collecting recess trench.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring

way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Horng et al. or Miyasaka et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Horng et al. nor Miyasaka et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

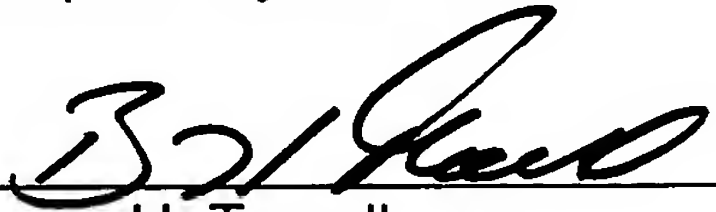
Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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